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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,166	10/16/2001	Kent D. Vincent	10005747-1	5610

7590 08/18/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/981,166	VINCENT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sheeba Ahmed	1773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 56, 63 and 68-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55, 57-62, 64-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Response to Amendment***

1. Applicants Response submitted in May 27, 2004 has been entered in the above-identified application.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-54, 61, 62, and 64-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of U.S. Patent No. 6,556,470 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because US 6,556,470 B1 claims a colorant for a substrate to form an erasable writable surface wherein the colorant comprises a molecular system of electrochromic, switchable molecules wherein each of said molecules is switchable between at least two optically distinguishable states, wherein each molecule exhibits a local electric

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field induced band gap change via a molecular conformation or an isomerization and wherein each molecule includes at least one stator and at least one rotor portion wherein said portion rotates from a first state to a second state in response to an applied electric field and wherein the first state there is extended conjugation throughout said molecular system and a larger band gap is obtained when the extended conjugation is destroyed (Claim 1). The colorant molecules can be arranged to form discrete addressable picture elements on the surface of the substrate (Claim 18) and wherein the molecules are switchable between a transparent state and an opaque state (Claim 21). The colorant is printed on a substrate for overhead projection use (Claim 23). The colorant molecules are bistable providing a non-volatile component (claim 24) or can have a low activation barrier between the different states and a fast volatile switch (Claim 37).

The claims of US 6,556,470 B1 do not recite an addressable display.

However, it would have been obvious to one having ordinary skill in the art to use the colorant taught in US 6,556,470 B1 in an addressable display given that claim 18 specifically claims that the colorant molecules can be arranged to form discrete addressable picture elements on the surface of a substrate.

### ***Response to Arguments***

3. Applicant's arguments filed on May 27, 2004, have been fully considered but they are not persuasive. Applicants traverse the rejection of claims 1-54, 61, 62, and 64-67 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-67 of U.S. Patent No. 6,556,470 B1 and submit that the present invention is directed to high resolution displays whereas US 6,556,470 is directed to a colorant and hence, the Applicants argue, a display apparatus is not obvious from a colorant.

However, the Examiner would like to point out that US 6,556,470 specifically claims a colorant for a substrate to form an erasable writable surface wherein the colorant molecules can be arranged to form discrete addressable picture elements on the surface of the substrate and hence it would have been obvious to one having ordinary skill in the art to use the colorant taught in US 6,556,470 B1 in an addressable display given that claim 18 specifically claims that the colorant molecules can be arranged to form discrete addressable picture elements on the surface of a substrate.

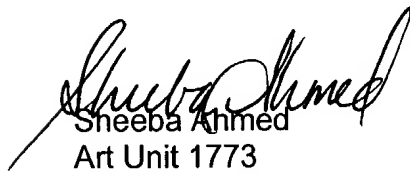
### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 9am to 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571)272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sheeba Ahmed  
Art Unit 1773  
August 16, 2004